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In re Application of
BOHM, Christer *et al*
U.S. Application No.: 09/581,776
PCT No.: PCT/SE98/02360
Int. Filing Date: 17 December 1998
Priority Date: 18 December 1997
Attorney Docket No.: AB-1006 US
For: METHOD AND APPARATUS FOR
SWITCHING DATA . . .

DECISION

UNDER

37 CFR 1.47(a)

This decision is in response to applicants' "Petition Under 37 CFR 1.47(a) in Connection With an Inventor Who Refuses to Sign the Declaration" ("Pet.") submitted 13 November 2000.

BACKGROUND

On 17 December 1998, applicants filed international application PCT/SE98/02360 claiming priority to a Swedish patent application filed 18 December 1997. A copy of the international application was communicated from the International Bureau to the United States Patent and Trademark Office on 24 June 1999.

On 13 July 1999, a Demand was filed with the International Preliminary Examination Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. Accordingly, the deadline for submission of a copy of the international application and payment of the basic national fee was extended to expire thirty months from the priority date, *i.e.*, 19 June 2000 (18 June 2000 was a Sunday).

On 16 June 2000, applicants filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, authorization to charge Counsel's Deposit Account No. 19-2386 for the basic national fee and any additional fees which may be required.

On 19 July 2000, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) must be provided.

On 13 November 2000, applicants submitted a "Response to Notification of

Missing Requirements Under 35 U.S.C. 371 Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" which was accompanied by, *inter alia*, the instant petition; a three-month extension request and \$445.00 extension fee; the \$65.00 surcharge fee; the \$130.00 petition fee; a verified statement claiming small entity status; and a document titled "Declaration of Roland Johansson in Support of Petition Under 37 CFR 1.47(a) in Connection with an Inventor who Refuses to Sign Declaration" ("Johansson Decl.")

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor refuses to execute the application; (3) a statement of the last known address of the missing joint inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor. Applicants failed to satisfy item (2).

Concerning item (1), the \$130.00 petition fee has been paid.

With regard to item (3), the 37 CFR 1.47(b) applicants state that the last known address of the nonsigning co-inventor, Elling Disen is:

c/o Williamsson
Svarvargatan 5
SE-112 49 Stockholm
Sweden

This satisfies item (3).

Regarding item (4), applicants included a Declaration signed by four of the five co-inventors. The nonsigning co-inventor's name, residence, post office address and citizenship are typed on the declaration. This declaration satisfies the requirements of section 409.03(a) of the Manual of Patent Examining Procedure (MPEP) and is in compliance with 37 CFR 1.497(a) and (b). Thus, item (4) has been satisfied.

Concerning item (2), applicants are claiming that "Elling Disen, has refused to sign the Declaration." Pet. ¶ 3. In support of this claim, applicants submitted a declaration of Mr. Roland Johansson who states that "Mr. Disen has informed me and one of the joint inventors . . . that he is unwilling to execute any documents with respect to filing this application." Johansson Decl. ¶ 2. He then declares that [i]n September, 2000, Net Insight AB orally requested Mr. Disen to sign the Declaration . . . Mr. Disen declared that he was not prepared to sign. *Id.* Mr. Johansson claims that Mr. Disen also told Mr. Lindmark that he would not sign after Mr. Lindmark talked to Mr. Disen and his attorney. *Id.* However, a declaration of Mr. Lindmark was not included to support this assertion. Finally, Mr. Johansson concludes that "Mr. Disen has thus not signed and returned the requested Declaration but informed me and Mr. Lindmark that he will

not do so." Id.

Section 409.03(d) of the MPEP explains what is required to prove a refusal by an inventor and states, in part:

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In this case, applicants claim that Mr. Disen expressly refused to sign the Declaration for the above-captioned application. *See above.* However, the specific facts of these refusals are not included in Mr. Johansson's declaration including the date and circumstances surrounding the incident. Applicants must also state any reason (if known) that Mr. Disen has for refusing to sign the application. In addition, a declaration from Mr. Lindmark pertaining to the nonsigning inventor's express refusal with his attorney present to Mr. Lindmark is also required since the PTO does not accept hearsay evidence.

Furthermore, section 409.03(d) adds another requirement that applicants must meet when proving a refusal by an inventor and states, in part that:

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature.

Here, applicants have not demonstrated that a complete copy of the above-captioned patent application was mailed to Mr. Disen. Applicants must show that Mr. Disen received a complete copy of the above-captioned application including the specification, claims and drawings to satisfy item (2). Moreover, any documentary evidence including certified mail receipts should be included with the renewed petition.

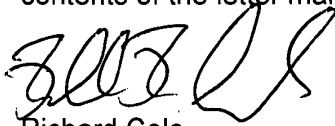
Accordingly, since applicants failed to meet item (2), it is not appropriate to accept this application under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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